

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 26 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ESTHER S. TAKEUCHI

Appeal No. 2002-0149
Application No. 09/176,374

ON BRIEF

Before PAK, KRATZ and PAWLIKOWSKI, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand the above identified application because it is not yet in condition for resolution of all the issues advanced by the appellant and by the examiner on this appeal.

In the final action (Paper No. 10), the examiner set forth several rejections, one of which concerns whether or not several of the claims on appeal (claims 5, 6, 8, 9, 16, 17 and 18) are in violation of the second paragraph of 35 U.S.C. § 112. In explaining that rejection, the examiner indicates that "extending

crosswise of said axis" as recited in claims 5, 8 and 16 is undefined and unclear in meaning as used in those claims, as well as claims 6, 9, and 17, which depend therefrom. See page 3 of the final action.

In an amendment (Paper No. 11) submitted after that final action, appellant proposed changes to claims 1, 5, 8 and 16, including, inter alia, replacement of that "extending crosswise of said axis" language of claims 5, 8 and 16 with the new language "that lies in a plane which is parallel to the plane containing the axis" Entry of those amendments would not only affect those claims, but all of the claims depending therefrom.

In an advisory action (Paper No. 12), the examiner approved entry of the amendment after final (Paper No. 11) upon the filing of a Notice of Appeal and Appeal Brief.

Subsequent to appellants' appeal and submission of a brief, the examiner issued an examiner's answer (Paper No. 16) wherein the examiner maintains a rejection of claims 5, 8 and 16 under the second paragraph of 35 U.S.C. § 112. At page 3 of that answer, the examiner refers to the final action (Paper No. 10) for the statement of that § 112, second paragraph rejection notwithstanding the fact that the final rejection refers to language

no longer present in claims 5, 8 and 16 as a result of the amendment after final action submitted by appellants.¹ The examiner does not further explain that rejection in the answer in light of the modified claim language or respond to appellant's arguments made at pages 10-12 of their brief. Nor does the examiner explain why claims 5, 8 and 16 are subjected to that rejection but claims 6, 9 and 17, which depend therefrom are no longer so rejected.

Consequently, at this point it would be premature for us to resolve that issue.

Accordingly, the subject application is being returned to the jurisdiction of the examiner for physical entry of the previously approved amendment after final action. The examiner must clarify the basis for the rejection of claims 5, 8 and 16 under 35 U.S.C. § 112, second paragraph in light of that amendment should the examiner maintain that rejection. Of course, the additional development of the application file record which is necessitated by the above discussed circumstances cannot be attained, as a practical matter, via the limited framework of supplements to the examiner's answer should the examiner decide

¹ We note that the amendment has not as yet been physically entered as required.

to maintain that rejection on an entirely new theory based on the new language of claims 5, 8 and 16 and also extend that rejection to dependent claims 6, 9 and 17. As a consequence, the examiner must reopen prosecution if any new basis for maintaining a § 112, second paragraph rejection is pursued in responding to this remand.

Additionally, as part of this remand, the examiner should also reconsider the § 103 rejection maintained in the answer in light of the amendments entered after final action and the arguments furnished in the briefs.

APPROPRIATE ACTION

We remand this application to the examiner for action consistent with the above.

REMANDED

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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